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MAR 15 2005

**OFFICE OF PETITIONS**

In re Application of :  
Goldenberg, Hansen, and Leung :  
Application No. 10/672,278 : DECISION ACCORDING STATUS  
Filed: 29 September, 2003 : UNDER 37 CFR 1.47(a)  
Attorney Docket No. 40923-0134US1 :  
:

This is in response to the petition filed under 37 CFR 1.47(a) on 9 February, 2005.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.**  
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 29 September, 2003, without an executed oath or declaration. Accordingly, on 22 December, 2003, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring the statutory basic filing fee, additional claim fees, an executed oath or declaration, a surcharge for their late filing, replacement drawings in compliance with 37 CFR 1.84 and 1.121, and sequence listing in compliance with 37 CFR 1.821-1.825. In response, on 21 May, 2004, petitioners filed a three month extension of time, accompanied by petitioners filed replacement drawings, a corrected sequence listing, the statutory

basic filing fee and additional claim fees, and surcharge and a declaration naming David M. Goldenberg, Hans J. Hansen, and Shui-on Leung as joint inventors and signed by joint inventors Goldenberg and Hansen on behalf of themselves and joint inventor Leung.

Accordingly, on 9 July, 2004, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring the signature of joint inventor Leung on the declaration. In response, on 9 February, 2005, petitioners filed a five (5) month extension of time, the present petition, and petition fee.

Petitioners assert that a copy of the declaration was sent to the non-signing inventor via his counsel. However, the non-signing inventor himself sent a letter on 8 November, 2004, stating that he required payment and another copy of the application.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (2). In regards to item (2), the declaration filed on 21 May, 2004, is defective in that it does not list the residence for any of the inventors.<sup>1</sup> Petitioners must provide a supplemental declaration signed by all of the signing inventors on behalf of themselves and the non-signing

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<sup>1</sup>MPEP 605.02 Applicant's Residence

Applicant's place of residence, that is, the city and either state or foreign country, is required to be included in the oath or declaration in a nonprovisional application for compliance with 37 CFR 1.63 unless it is included in an application data sheet (37 CFR 1.76). In the case of an applicant who is in one of the U.S. Armed Services, a statement to that effect is sufficient as to residence. For change of residence, see MPEP § 719.02(b). Applicant's residence must be included on the cover sheet for a provisional application unless it is included in an application data sheet (37 CFR 1.76). Id.

inventor. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, listing the residence, mailing address, and citizenship of all of the inventors and signed by the signing inventors on behalf of themselves and the non-signing inventors must be provided with any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail:            Mail Stop Petition  
                          Commissioner for Patents  
                          P.O. Box 1450  
                          Alexandria, VA 22313-1450

By FAX:            (703) 872-9306  
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By hand:            Customer Service Window  
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                          Randolph Building  
                          401 Dulany Street  
                          Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



Douglas I. Wood  
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Office of Petitions